



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,210	02/06/2002	Oussama Zbib	010158	7042

7590 02/25/2005

Johnathan C. Parks, Esq Kickpatrick & Lockhart
LLP Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, PA 15222-2312

EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/068,210

Applicant(s)

ZBIB, OUSSAMA

Examiner

Yogesh C Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/1/2003 & 2/6/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The examiner acknowledges the receipt of formal drawings on 4/1/2003 and they are accepted.

Claim Rejections - 35 USC § 112, First Paragraph

2. The following is a quotation of the first paragraph of **35 U.S.C. 112**:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 and 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The system claim 1 and apparatus claim 18 recite the limitation " using the device to retrieve information from the server based on a limited knowledge of the individual" and this subject matter was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification describes, see paragraph 0027, page 9 that the device is able to retrieve information from the server by inputting server's URL and terms displayed in an advertisement but does not describe that the device uses the knowledge in the mind of the individual. Since claims 2-9 and 19-20 are dependencies of claims 1 and 18 respectively, they will also inherit the same deficiency.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-9, 10-15, 17, 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Minte (US Publication 2002/0046118 A1).

Note: Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Regarding claims 1 and 6, Minte discloses a system for retrieving information about an advertisement that was viewed by or heard by an individual (see at least abstract, ".....*An advertising method that couples advertising content of several advertising media together, one of the media being the World Wide Web. Identifiers are included in initial advertisements*

placed in Web and non-Web media, and direct the person viewing or hearing those advertisements to a Web site that is a collection of linked Web-pages containing additional information relating to the initial advertisements. The viewer can click on advertisement-specific "buttons" to get further information about one or more of the products or services advertised in the initial advertisement ") comprising an advertisement content server having files containing about the advertisement (see Fig.1, " Mall site 40....tvadfinder.com...", and paragraphs 0043-0044), a device for accessing the information via a communication network (see at least paragraph 0045 which teaches that the server at Mall site 40 is accessed by a Web user and the Web user would inherently use a client on a computer for accessing the information via a communication network). Minte further suggests that the Web user is enabled to retrieve a subset of information from the content server [inherently by a client device via a communication network, such as a computer from home or office or from a wireless if the user is mobile and these devices are known to be in use at the time of the applicant's invention] based on a limited knowledge concerning the advertisement (see at least paragraphs 0044-0045). The "Bug or identifier 30" corresponds to the limited knowledge in one of the many possible forms, such as URL or a visible icon, etc. which helps the Web user to search and retrieve the information concerning the advertisement.

Regarding claim 2, Minte discloses a broadcast media outlet that broadcasts the advertisement (see at least Fig.1, "10 Television Advertisement ", and paragraph 0043).

Regarding claims 3-4, Minte discloses that the advertisement includes a name and geographic location of the broadcast media outlet (see at least paragraph 0032, "*..... this context-sensitive embodiment, slightly modified Bugs may be used for a particular commercial, depending on the context in which the commercial is shown. Context-information may include, for example, the television show, the time during which, or the geographic location where, the commercial is shown.....*") and name a contact information for an advertiser (see at least paragraph 0025, "*... The advertising-contractor provides an identifier that relates the subscribing advertiser's advertisement in the first advertising medium with the extended advertising content on the World Wide Web. This identifier is a visual and/or audio cue, depending on what type of cue is effective for the particular medium. This identifier can be directly attached to the subscribing advertiser's advertisement, such as a visual icon on the advertisement, or can be separate from the advertisement, but is a pointer that directs the viewer to another medium for more information about the particular advertisement(s) of interest. This cue is typically a URL-pointer that is placed in one or more first advertising media, and is hereinafter referred to as a "Bug,". The Bug directs the viewer to the advertising-contractor's extended advertising content, that is, creates a link between the advertisements of a group of subscribing advertisers and the extended advertising content, irrespective of the particular first advertising medium or subscribing-advertiser.*" . Note: "URL" is the contact information and as regards providing information about name, this limitation is already covered in claim 3.

Regarding claim 5, Minte teaches that the advertisement is segmented into searchable fields (see at least Fig.1, " 51 Computer screen" which shows segmented fields in the form of " Specials", Purchase", Coupon", etc.

Art Unit: 3625

Regarding claims 8-9, Minte discloses an activity log for recording information retrieval events (see at least paragraph 0031) and payment instructions (see at least paragraph 0034, " ... *Additionally, depending on the retailer, the consumer may execute order or payment transactions right from the Mall-site via secured servers, or through the retailer's or other third party's secured server.* " "

Regarding claims 10, 12-15, 17-18 and 20, their limitations are closely parallel to the limitations of claims 1-6 and 8-9 and are therefore analyzed and rejected on the same basis.

Regarding claim 11, Minte teaches determining a location of the device and transmitting information that is identified as having a relationship with the location of the device (see at least paragraph 0034).

Claim Rejections - 35 USC § 103

4 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minte and further in view of Moon (US Patent 6,545,596).

Regarding claims 7, 16 and 18, Minte discloses a device which is used by a Web user for accessing the information from the server as analyzed in claims 1, 10 and 18 above but does not explicitly disclose that the device includes a wireless device. Moon, in the field of same endeavor, discloses wireless devices being used to access advertisement information from the server (see at least col.2, line 35-col.3, line 18). In view of Moon, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Minte to incorporate the feature of including a wireless device to access the information from the server because it would enable the advertisers to broadcast advertisements to people while they are traveling in automobiles or otherwise which ultimately would help in increasing the revenues and profits for the sellers.

Conclusion

5 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,829,475 to Lee et al. (see at least col.4, line 64-col.5, line 19; col.6, line 14-col.8 line 25) and US Publication 2002/0046084 to Steele et al. (see at least paragraphs 0019-0022, 0031, 0034, 0037, 0041,0056, 0063-0066) disclose a system, a method and apparatus for retrieving information about an advertisement that was viewed or heard by an individual and either anticipates or renders obvious the limitations recited in claims 1-20 of the instant application.

(ii) US Patent 6,744,753 to Heinonen et al. discloses a solution to the problem of enabling a mobile wireless device to resume an Internet contact with a server if the

Art Unit: 3625

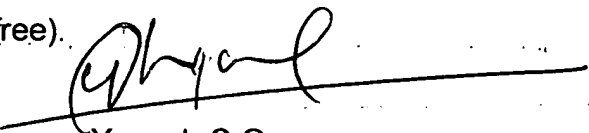
contact is interrupted by accessing a stored handover address (see at least abstract and col.4, lines 8-23).

(iii) US Publication 2002/0032035 to Teshima discloses an apparatus and method for delivery of advertisements to mobile units (see at least abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
February 17, 2005